

REMARKS

The Examiner has subjected this application to a restriction requirement under 35 U.S.C. 121. Applicants have previously provisionally elected claim Group I, directed to claims 1-9, 11, 13-15 and 28-33, with traverse. The Examiner has now deemed this requirement to be final. Reconsideration is respectfully requested. Since the method claims contain all of the limitations of the article claims, the method claims should be rejoined under *In Re Ochiai* 37 USPQ2d 1127 and *In re Brouwer* 37 USPQ 1663. It is therefore respectfully urged that the restriction requirement be rescinded and the non-elected claims rejoined.

The Examiner has rejected claims 1-9, 11, 13-15 and 28-33 as unpatentable under 35 U.S.C. 103 over Kim et al. in view of Beer et al. Applicants respectfully submit that the rejection is incorrect.

The claims have been amended to define an invention which is a film which comprises at least one fluoropolymer layer and at least one cyclo olefin polymer layer comprising at least cyclo olefin homopolymer or copolymer attached to a surface of said fluoropolymer layer by an intermediate adhesive layer, wherein said intermediate adhesive layer comprises a polyolefin having at least one functional moiety of an unsaturated carboxylic acid or anhydride thereof. Such a combination is not shown or suggested by the art.

The Examiner and Applicants agree that individually, Kim and Beer differ from the claimed invention. Particularly, while Kim et al. discloses multilayer films including a layer of a fluoropolymer and an adhesive layer that may comprise a polyolefin modified with a carboxylic acid or acid anhydride, it does not teach multilayer films including a cyclic olefin polymer layer as required by the present claims. Further, while Beer, et al. discloses multilayer films including a cyclic olefin polymer layer, it does not teach multilayer films including either a fluoropolymer layer or intermediate adhesive layer which comprises a polyolefin having at least one functional moiety of an unsaturated

carboxylic acid or anhydride thereof. It is the permissibility of the proposed combination of these two references where the Examiner and Applicants disagree.

Applicants respectfully submit that the combination of Kim, et al. and Beer, et al. is an impermissible combination of references because neither of the references offers the requisite motivation to combine the references, either explicitly or implicitly.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (CAFC 1987) *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987) ("Based upon the prior art and the fact that each of the three components of the composition used in the claimed method is conventionally employed in the art for treating cooling water systems, the board held that it would have been *prima facie* obvious, within the meaning of 35 U.S.C. 103, to employ these components in combination for their known functions and to optimize the amount of each additive.... Appellant argues... hindsight reconstruction or at best,... 'obvious to try'.... We agree with Appellant."). See also *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

The Examiner has argued that the proposed combination is proper because Kim discloses the use of polyvinyl chloride and polypropylene thermoplastic layers, while Beer states that a COC/PVdC (no tie layer) film has better water vapor barrier properties than a PVC/polyethylene tie-layer/PVdC film (col. 2, lines 60-65), and that cyclic olefin polymers used as base films in multilayer films as described in EP-A-570 188 and EP-A-631 864 have shown good processability. Applicants' respectfully disagree that this disclosure in Beer thereby establishes COC as a polymer with superior properties to PVC and polypropylene. The data from Table 1 of Beer that the Examiner points to compares the water vapor transmission properties of a COC/PVdC film that has no adhesive layer, to a PVC/tie/PVdC film having a polyethylene tie layer. It is respectfully submitted that the improvement in properties in COC films that do not incorporate an adhesive tie layer is likely due to the absence of the tie layer. It is well known that many adhesive tie layers, e.g. polyethylene tie layers, crystallize when heat sealed to structures (e.g. containers), thereby causing a significant impact on the water vapor barrier properties of

their overall multilayer films. Accordingly, the elimination of a tie layer results in a significant increase in barrier properties. Unfortunately, adhesive tie layers are typically required in most multilayer films require to attach two thermoplastic film layers. Therefore, while the COC/PVdC films of Beer et al. may have an improved water vapor barrier compared to a PVC/PE-tie/PVdC film, that is not conclusive that a COC/PVdC film will have an improved water barrier property compared to a COC/PE-tie/PVdC film.

Additionally, the processability of a multilayer film can also be significantly effected by the other layers contained in a multilayer film. While Beer et al. discusses how the thermoformability of COC mono- and multilayer films from EP-A-570 188 and EP-A-631 864 compare to unoriented polypropylene, this also fails to take into account the other film structures contributing to film thermoformability, as well as the properties of *oriented* polypropylene. It is respectfully submitted that the specific picking and choosing of favorable comparison data in Beer, et al. does not evince the superiority or interchangeability of COC films with PVC films or PP films. Accordingly, it is respectfully submitted that one of ordinary skill in the art would not be motivated to substitute a COC layer from Beer, et al. for the PVC or polypropylene layers of Kim, et al. as the Examiner asserts.

It is further respectfully submitted that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is nothing in Kim, et al. that suggests the desirability of attaching a cyclic olefin polymer layer to a fluoropolymer layer. Further, there is nothing in Beer, et al. that suggests the desirability of attaching a cyclic olefin polymer layer to a fluoropolymer layer via an intermediate adhesive layer comprising a polyolefin having at least one functional moiety of an unsaturated carboxylic acid or anhydride thereof. While Beer does suggest the desirability of a COC/PVdC film because of the ability to eliminate an adhesive layer, and cites the better thermoformability properties of COCs compared to unoriented polypropylene, Beer does not teach or suggest the desirability of cyclic olefin polymers in general compared to other polymer layers. Rather, Beer simply presents

cyclic olefin polymer layers *as an alternative* to other thermoplastic polymer layers that *one can use, not that one should use*, in a multilayer film. It is respectfully submitted that this is not proper motivation to combine the references. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

It is respectfully submitted that the Examiner is using improper hindsight reasoning to combine the applied references. Applicants assert that only through their work was it discovered that the claimed adhesive compositions exhibit good bond strength between a fluoropolymer layer and a cyclic olefin polymer layer. Prior to Applicants' discovery, one would not even see a benefit to adhering a cyclic olefin polymer to a fluoropolymer layer to make a blister package or other film structure. The point in time that is critical for an obviousness determination is at the time the invention. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

With particular regard to claims 6 and 7, as the Examiner states, both Kim et al. and Deer et al. fail to teach the *degree* of uniaxial or biaxial orientation as required by the present claims 6 and 7. The Examiner states that it would be obvious for one skilled in the art to orient the film within the presently claimed range. Applicants again respectfully submit that the Examiner is using an impermissible "obvious to try" standard of patentability. The fact that one skilled in the art *could* orient a film within the inventive range does not show that one skilled in the art would have any motivation *per se* which would lead them

to do so. Also, the orientation does not overcome the problem of non-suggestion to form the adhered film in the first instance.

Regarding claims 32-33, the product by process result is neither identical with nor only slightly different than that in the prior art as stated above. It is respectfully submitted that one would not have sufficient motivation to look to Beer, et al. in combination with Kim, et al. to arrive at the claimed invention, and that one skilled in the art would not be inspired to form the inventions of the claims upon a combined reading of Kim et al. with Beer et al. For the foregoing reasons it is submitted that the claimed invention is not obvious in view of the applied art and it is requested that the rejection be withdrawn.

The Examiner has rejected claims 1, 3, 13, 14, and 28 under 35 U.S.C. 102 over Muggli in view of Schmiletsky. Applicants respectfully submit that this ground of rejection is incorrect.

The claims specify that the intermediate adhesive layers of the invention comprise a polyolefin having at least one functional moiety of an unsaturated carboxylic acid or anhydride thereof. These adhesives are not described by Muggli. The Examiner hereby applies Schmiletsky which discloses that polyurethane is a suitable laminating adhesive for use in blister packages.

It is respectfully submitted that the combination of Muggli and Schmiletsky still fails to obviate the claims as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schneck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). It is respectfully asserted that while individual pieces of the invention can be found in the applied art, the invention as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made because there is no teaching or suggestion to combine the references as the Examiner has done.

Further, the Patent and Trademark Office Board of Appeals and Interferences stated the following in *Ex parte Clapp*, 227 USPQ 972 (1985), at page 973:

Presuming arguendo that the references show the elements or concepts urged by the Examiner, the Examiner has presented no line of reasoning, and we know of none, as to why the artist when viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the Examiner has done little more than cite references to show that one or more elements or some combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to the combination of elements. That is to say, applicant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion of the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination where the Examiner must present a convincing line of reasoning as to why the artist would have found the claimed invention to have been obvious in light of the teaching of the references.

With the above directives, consideration must be given as to whether the combination of references in the manner set forth in the Office Action is proper to render the Applicants' invention obvious in view thereof. It is respectfully submitted that, the Examiner has presented no line of reasoning as to why the artist when viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention.

The Examiner states that since Schmiletzky shows that polyurethane is "at least equivalent" to other laminating adhesives used in blister packs, that one of ordinary skill in the art would have found it obvious to substitute polyurethane as the laminating adhesive in the blister package of Muggli. First it is noted that the claims have been amended to remove a urethane as an adhesive later. It is respectfully submitted that it is not sufficient for the Examiner to apply an "at least equivalent" standard for combining references under 35 U.S.C. 103. There must be something in the applied references that

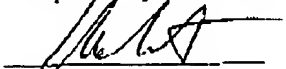
clearly teaches or suggests that one skilled in the art should form the claimed invention upon a reading of the references, rather than the simple assumption that one could achieve the claimed invention from the teachings of the references after reading of Applicants' disclosure. This is absent in the applied references.

Applicants respectfully submit that the Examiner is looking beyond the teachings of the reference and reconstructing the art in light of Applicants' disclosure. Neither of the cited references, alone or in combination, teach or suggest the structure of the films taught according to the present invention. The ancient argument that a building design is not obvious in view of a pile of bricks and mortar from which it is constructed, is equally applicable here.

It is therefore respectfully urged that the 35 U.S.C. 103 rejections are overcome and should be withdrawn. Such action is requested.

The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the Examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (FAX No. 703-872-9306) on January 5, 2005.


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